

REMARKS

I. Introductory Comments.

Claims 1, 3-9, and 11-31 are pending, and claims 1, 9, 17, and 24 are independent claims. No claims have been canceled or amended.

In the Office Action, claims 1, 3-9, and 11-31 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Applicants' Background of the Invention, U.S. Patent Application Publication No. 2002/0138416 ("Applicants' Background"), in view of Kalyan (U.S. Patent No. 6,266,655), and in further view of Norton (U.S. Patent Application Publication No. 2002/0091699).

In view of the following arguments, all claims are believed to be in condition for allowance. Therefore, this response is believed to be a complete response to the Final Office Action. However, Applicants reserve the right to set forth further arguments supporting the patentability of their claims, including the separate patentability of the dependent claims not explicitly addressed herein, in future papers.¹ Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

II. Independent Claims 1, 9, 17, and 24 Are Patentable Over The Cited References.

Independent claims 1, 9, 17, and 24 were rejected under Section 103(a) as allegedly being unpatentable over Applicants' Background in combination with Kalyan and Norton. However, Applicants' Background is merely background information, and does not teach or suggest numerous recitations found in Applicants' claims, as discussed in detail below. In addition, there

1. As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such assertions/requirements in the future.

is no teaching, suggestion, or motivation to combine Kalyan and Norton with Applicant's Background.

A. Independent Claim 1

1. *“inventorying a plurality of assets of the organization, wherein each asset is defined to be one of an electronic asset type and a location asset type . . . and the location asset type includes physical locations where the electronic asset types are placed.”*

The Examiner alleged that the “Inventory and definition” section of Applicants’ Background teaches the identified recitation of claim 1. (Office Action, page 3.) Specifically, the Examiner stated that Applicant’s Background teaches the identified recitations by teaching that “[i]n order to measure the theoretical impact of a risk, the organization determines its assets (e.g., electronic devices, electronically stored data, etc.) that are involved in support of critical processes.” (Office Action, page 4.)

However, the cited portions of Applicants’ Background say nothing at all about how “each asset is defined to be one of an electronic asset type and a location asset type,” as recited in claim 1. Applicants’ Background merely states that “the organization determines its assets,” and provides examples of assets, such that assets can be “electronic devices, electronically stored data, etc.” (Applicants’ Background: page 4, lines 11-13.) In addition, Applicants’ Background fails to teach or suggest that “each asset is defined to be one of an electronic asset type and a location asset type.” Further, the cited portions of Applicants’ Background say nothing at all about how “the location asset type includes physical locations where the electronic asset types are placed.”

Applicants’ Background mentions that “[t]here are a number of conventional automated tools which can assist the organization in accomplishing this phase of the process. These tools . . . are able to map network systems and devices and produce reports showing OS (operating system) type, revision level and the services that a system is making available to a network.” (Applicants’ Background: page 4, lines 17-23.) However, such tools cannot automatically determine an asset’s location, let alone teach that “the location asset type includes physical

locations where the electronic asset types are placed,” as recited in claim 1. Therefore, for this reason alone, claim 1 is patentably distinct.

2. “identifying at least one criterion defining a security objective of the organization.”

The Examiner alleged that the “Vulnerability and threat evaluation” section of Applicants’ Background teaches the identified recitation of claim 1. (Office Action, page 4.) However, Applicants’ Background not only fails to teach or suggest the identified recitation, but actually teaches away from “identifying at least one criterion defining a security objective of the organization.”

Applicants’ Background fails to teach or suggest “identifying at least one criterion *defining a security objective of the organization.*” Instead, Applicants’ Background states that “[i]n this phase, the organization is examined for weaknesses that could be exploited by an unauthorized outsider, and the chances of an outsider attacking those weaknesses.” (Applicants’ Background: page 5, lines 1-3.) Thus, for this additional reason claim 1, is patentable over the cited references.

3. “identifying one or more inventoried assets that relate to the identified criterion.”

The Examiner alleged that Applicants’ Background teaches the identified recitation by stating that “[o]nce assets have been identified, a value is assigned to each asset.” (Office Action, page 4.) However, the cited portion is actually discussing steps performed *after* assets have been identified, and clearly fails to teach or suggest “identifying one or more inventoried assets that relate to the identified criterion,” as recited in claim 1. Further, assigning a value to an asset is clearly distinguishable from “identifying one or more inventoried assets that relate to the identified criterion.” Specifically, Applicants’ Background fails to teach or suggest “identifying one or more inventoried assets *that relate to the identified criterion,*” as recited in claim 1.

The cited portion of Applicants’ Background states “[o]nce assets have been identified, a value is assigned to each asset.” (Applicants’ Background: page 4, lines 13-14.) Applicants’

Background suggests assigning a value to a previously identified asset. However, the cited portions of Applicants' Background say nothing at all about "identifying at least one criterion defining a security objective of the organization," and thus clearly fail to teach or suggest "identifying one or more inventoried assets that relate to the identified criterion." Notably, the cited portion clearly says nothing at all about identifying an asset that relates to the identified criterion. Thus, for yet a further reason, claim 1 is in condition for allowance.

4. *"assessing the risk to the organization based on the measured values of the one or more metric equations."*

Independent claim 1 further recites in part "assessing the risk to the organization based on the measured values of the one or more metric equations." The Examiner alleged that Applicants' Background teaches this recitation, and relied on the statement that "[o]nce risk has been assessed and identified, the organization can choose to accept the risk, mitigate the risk, or transfer the risk." (Office Action, page 4.) However, the cited portion is actually discussing an organization's options *after* assessing the risk, as opposed to "assessing the risk." Further, Applicants' Background states that "[t]his phase of the process allows an organization to evaluate the cost of the countermeasure versus the value of the asset to be protected by the countermeasure." (Applicants' Background: page 7, lines 21-23.) Thus, Applicants' Background clearly fails to teach or suggest "assessing the risk to the organization based on the measured values of the one or more metric equations." Thus, for yet this additional reason, claim 1 is patentable over the cited references.

5. *“formulating one or more metric equations for each identified criterion . . . each metric equation being defined, in part, by the one or more identified assets, wherein each metric equation yields an outcome value when one or more measurements are made relating to the identified assets.”*

The Examiner admitted that Applicants' Background fails to teach or suggest the identified recitations, and cited Kalyan and Norton to compensate for the deficiencies of Applicants' Background. (Office Action, page 4.) The Examiner stated that “Kalyan discloses the formulating and solving of equations for identified criteria,” and pointed to Kalyan's Abstract and elements 43 and 44 of Figure 4. (Office Action, page 4.) Specifically, the Examiner stated that “Kalyan discloses the formulating and solving of equations for identified criteria utilizing a computer.” (Office Action, page 4.) However, Kalyan is not directed to the subject matter of Applicants' Background or Applicants' claims, nor is the section cited by the Examiner relevant to the identified recitations.

Kalyan is directed to developing a monetary value of resources for a manufacturer based on market demand, such as future uncertain demand for various products. For example, Kalyan states that the disclosure is directed to “[a] method of valuing resources of an asset intensive manufacturer.” (Kalyan: Abstract.) More specifically, Kalyan is directed to “valuing resources used to manufacture products” (Kalyan: col. 1, lines 43-45). Kalyan states that “[a]n example of an asset intensive manufacturing is steel manufacturing.” (Kalyan: col. 2, lines 49-50.) Further, Kalyan states “[v]alue management for asset intensive manufacturing is based on the following principle: Based on future uncertain demand for various products, expected prices for those products, and available capacities of resources during periods required to supply demand when demanded, a value for each resource during those periods can be calculated.” (Kalyan: col. 2, lines 54-59.) “The calculation results in *threshold prices*, referred to as minimum acceptable values (MAVs) for a given demand period.” (Kalyan: col. 2, lines 59-61, emphasis added.) Thus, Kalyan is wholly directed to valuing resources of a manufacturer, and has nothing to do with the subject matter in Applicants' Background or Applicants' claims. In addition, Kalyan clearly fails to teach or suggest the identified recitations.

The cited portions of Kalyan do not teach or suggest “formulating one or more metric equations *for each identified criterion*,” as recited in claim 1. Instead, Kalyan discloses valuing products and resources with one equation *per resource*, not *per criterion*. In Figure 4, Kalyan “illustrates how MAV [minimum acceptable values] equations are set up and solved.” (Kalyan: col. 2, lines 20-23.) Figure 4 is a flow chart, where element 43 is the third process step and states “set up N_R equations each with only one variable, the corresponding λ ,” where λ represents “the resource.” (Kalyan: Figure 4; and col. 7, line 38.) Further, element 44 is the following process step and states “solve each equation using a binary tree to converge to a new λ for each equation.” (Kalyan: Figure 4.) Kalyan fails to teach or suggest “formulating one or more metric equations for each identified criterion.” To the contrary, Kalyan discloses valuing products and resources with one equation *per resource*, not *per criterion*.

Claim 1 recites that “a criterion” relates to “a security objective of the organization.” Clearly a resource that is used to manufacture a product is not, and cannot be equated with, “a criterion” that relates to “a security objective of [an] organization,” as recited in claim 1. Moreover, the differences between Kalyan and claim 1 can be seen in context, at least because the modeling in Kalyan is for the purpose of “valuing resources used to manufacture products” (e.g. Kalyan, col.1, lines 43-45), without regard to “at least one criterion defining a security objective of the organization.”

6. No Teaching or Suggestion to Combine Kalyan with Applicants' Background

The Examiner summarily concluded that “it would have been obvious to one of ordinary skill in the art to incorporate the teachings of Norton into ABI and Kalyan to effectively manage access to the asset information.” (Office Action, page 5.) However, there is no teaching or suggestion that would motivate one to combine Kalyan with Applicants' Background, as alleged by the Examiner.

Kalyan is directed to a method of valuing resources of an asset intensive manufacturer by utilizing “a computer-implemented tool that implements a ‘value-management’ (VM) pricing method.” (Kalyan: col. 2, lines 20-23.) Notably, Kalyan is directed to calculating the monetary

value of various resources during various periods by basing the value on certain principles, such as “future uncertain demand for various products, expected prices for those products, and available capacities of resources during periods required to supply demand when demanded.” (Kalyan: col. 2, lines 54-59.) Applicants’ Background, on the other hand, is directed to risk management, particularly for computer systems. Clearly, Kalyan is not directed to the recitations found in Applicants’ claims because Kalyan is concerned with valuing assets based on conceptualized market conditions. Further, without using Applicants’ claims as a road map, there is no teaching, suggestion, or motivation to combine Kalyan with Applicants’ Background.

Accordingly, for at least the foregoing reasons, claim 1, as well as claims 3-8 depending therefrom, are patentable over the cited references. In addition, Norton fails to compensate for the deficiencies of Applicants’ Background and Kalyan. Therefore, claims 1 and 3-8 are in condition for allowance.

B. Independent Claims 9, 17, and 24 Are Patentable Over The Cited References.

1. *“identify a plurality of assets of the organization, wherein each asset is defined to be one of an electronic asset type and a location asset type . . . and the location asset type includes physical locations where the electronic asset types are placed.”*

Although each independent claim includes differs in scope, the Examiner simply alleged that independent claims 9, 17, and 24 each “recites similar limitations to claim 1 and thus [are] rejected using the same art and rationale as in claim 1.” (Office Action, pages 6 and 7.) Independent claims 9 and 17 each include the identified recitations. Independent claim 24 recites in part “inventorying a plurality of assets of the organization, wherein each asset is defined to be one of an electronic asset type and a location asset type . . . and the location asset type includes physical locations where the electronic asset types are placed.”

As discussed above with respect to claim 1, the Examiner alleged that the “Inventory and definition” section of Applicants’ Background teaches the identified recitations. (Office Action, page 4.) However, Applicants’ Background clearly fails to teach or suggest that “each asset is defined to be one of an electronic asset type and a location asset type.” In addition, the cited

portions of Applicants' Background say nothing at all about how "the location asset type includes physical locations where the electronic asset types are placed."

2. *"identify a plurality of criteria, each criterion defining a security objective of the organization."*

Independent claim 9 includes the above-identified recitation. Independent claims 17 and 24 each recites in part "identifying at least one criterion defining a security objective of the organization." The Examiner alleged that the "Vulnerability and threat evaluation" section of Applicants' Background teaches this recitation. (Office Action, page 4.) However, also as previously discussed regarding claim 1, Applicants' Background fails to teach or suggest the identified recitation.

3. *"identify a plurality of inventoried assets that relate to each identified criterion."*

Independent claim 9 also includes the above-identified recitation. Independent claims 17 and 24 each recites in part "identify[ing] one or more inventoried assets that relate to the identified criterion." The Examiner alleged that the "Inventory and definition" section of Applicants' Background teaches this recitation. (Office Action, page 4.) However, also as previously discussed regarding claim 1, Applicants' Background fails to teach or suggest "identify[ing] a plurality of inventoried assets that relate to each identified criterion."

4. *"formulat[ing] one or more metric equations for each identified criterion."*

Independent claims 9, 17, and 24 each recites in part "formulat[ing] one or more metric equations for each identified criterion." The Examiner admitted that Applicants' Background fails to teach or suggest this recitation, and cited Kalyan to compensate for the deficiencies of Applicants' Background. (Office Action, page 5.) As previously discussed regarding claim 1, however, the cited portions of Kalyan do not teach or suggest "formulat[ing] one or more metric equations *for each identified criterion.*" In addition, there is no teaching, suggestion, or motivation to combine Kalyan with Applicants' Background.

Accordingly, for at least the foregoing reasons, independent claims 9, 17, and 24, as well as the claims depending therefrom, are patentable over the cited references. Therefore, claims 9 and 11-31 are in condition for allowance.

III. Dependent Claims 4, 12, 19, and 27 Are Patentable Over The Cited References.

“wherein the plurality of assets are defined to be one of a user type, a user population type, a data type and a network type in addition to the electronic type and the location type, wherein the user type relates to an individual user and the user population type relates to a group of users.”

The Examiner alleged that the “Inventory and definition” section of Applicants’ Background teaches the identified recitation. (Office Action, page 5.) However, the cited portions of Applicants’ Background clearly fail to teach or suggest that “the plurality of assets are defined to be one of a user type, a user population type, a data type, and a network type.” In fact, Applicants’ Background makes no mention of “a user type, a user population type, a data type, [or] a network type.”

Because Applicants’ Background fails to teach or suggest the above-identified recitation, claims 4, 12, 19, and 27 are in condition for allowance.

IV. Dependent Claims 5, 13, 20, and 28 Are Patentable Over The Cited References.

“establish[ing] at least one relationship between the plurality of assets.”

The Examiner admitted that Applicants’ Background fails to disclose the identified recitation, and cited Norton to compensate for the acknowledged deficiency of Applicants’ Background. (Office Action, page 5.) Specifically, the Examiner alleged that Norton teaches this recitation in Figure 8 and in paragraphs 85-90. (Office Action, page 5.)

Norton is directed to “[a] system and method for managing asset information . . . [such as part of] a total asset management system.” (Norton: Abstract.) The cited portions of Norton disclose a variety of “asset search options” that “enables a user not only to search for an asset, but also to view a range of detailed information about the selected asset.” (Norton: page 4, ¶¶ 85-87.) Norton further discloses that “[t]he Asset tab 70 displays detailed asset information for the asset selected,” and that such information may include the asset’s serial number, tracking

number, purchase order, manufacturer, model number, etc. (Norton: pages 4-5, ¶¶ 88-93.)

Figure 8 of Norton is simply a screen shot of a website showing “an exemplary display resulting from the selection of the Option Tab.” (Norton: page 2, ¶ 36.)

Norton clearly fails to teach or suggest “establishing at least one relationship between the plurality of assets.” Therefore, claims 5, 13, 20, and 28 are patentable over the cited references, including Norton.

V. Dependent Claims 6, 14, 21, And 29 Are Patentable Over The Cited References.

“link[ing] a first asset defined to be in one asset type with a second asset defined to be in another asset type.”

The Examiner stated that “[c]laims 6, 7, and 8 recite similar limitations to claim 5, and thus [are] rejected using the same art and rationale as in claim 5.” (Office Action, page 5.) However, dependent claims 6, 14, 21, and 29 recite in part “link[ing] a first asset defined to be in one asset type with a second asset defined to be in another asset type.” None of the cited references, including Norton, teach or suggest the identified recitation.

As previously discussed, Norton discloses a variety of “asset search options” that allow a user to search for an asset, and view detailed information about a selected asset. (Norton: page 4, ¶¶ 85-87.) Norton fails to teach or suggest “linking a first asset defined to be in one asset type with a second asset defined to be in another asset type.” Therefore, claims 6, 14, 21, and 29 are patentable over the cited references, including Norton.

VI. Dependent Claims 7, 15, 22, And 30 Are Patentable Over The Cited References.

“link[ing] a first asset defined to be in one asset type with a second asset defined to be in the same asset type.”

Again, the Examiner admitted that Applicants’ Background fails disclose the identified recitation, and cited Norton to compensate for the acknowledged deficiency of Applicants’ Background. (Office Action, page 5.) The Examiner alleged that Norton teaches this recitation on page 4 in paragraphs 85-90. (Office Action, page 5.) However, the cited portions of Norton say nothing at all about “linking a first asset defined to be in one asset type with a second asset

defined to be in the same asset type.” Therefore, dependent claims 7, 15, 22, and 30 are in condition for allowance.

CONCLUSION

All rejections have been addressed. In view of the above, the presently pending claims are believed to be in condition for allowance. Accordingly, reconsideration and allowance are respectfully requested and the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013, under order number 65632-0525. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

Dated: May 19, 2009

Respectfully submitted,

Electronic signature: /Justin S. Cohen/
Michael B. Stewart
Registration No.: 36,018
Justin S. Cohen
Registration No.: 59,964
RADER, FISHMAN & GRAUER PLLC
Correspondence Customer Number: 25537
Attorneys for Applicants